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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,347	01/11/2002	M. Judah Folkman	05213-0880 (43170-249874)	7487

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EXAMINER	
HUFF, SHEELA JITENDRA	

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,347	FOLKMAN ET AL.	
	Examiner	Art Unit	
	Sheela J Huff	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *21-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are cancelled.

Claims 21-40 are pending

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 21-22, drawn to nucleotide SEQ ID No. 4, classified in class 536, subclass 23.1.

II. Claims 21 and 23, drawn to nucleotide SEQ ID NO. 6, classified in class 535, subclass 23.1.

III. Claims 21 and 32, drawn to nucleic acid molecule encoding SEQ ID 1, classified in class 536, subclass 23.1.

IV. Claims 21 and 24, drawn to nucleic acid molecule encoding SEQ ID 2, classified in class 536, subclass 23.1.

V. Claims 21 and 24, drawn to nucleic acid molecule encoding SEQ ID 3, classified in class 536, subclass 23.1.

VI Claims 21 and 24, drawn to nucleic acid molecule encoding SEQ ID 5, classified in class 536, subclass 23.1.

VII. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide of SEQ ID No. 1 or derivative, analog or variants thereof, classified in class 514, subclass 12.

VIII. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide of SEQ ID No. 2 or derivative, analog or variants thereof, classified in class 514, subclass 12.

IX. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide of SEQ ID No. 3 or derivative, analog or variants thereof, classified in class 514, subclass 12.

X. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide of SEQ ID No. 5 or derivative, analog or variants thereof, classified in class 514, subclass 12.

XI. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide which is encoded by SEQ ID NO. 4, classified in class 514, subclass 12.

XII. Claims 33-40, drawn to a pharmaceutical composition comprising a polypeptide which is encoded by SEQ ID NO. 6, classified in class 514, subclass 12.

XIII. Claims 33-40 drawn to a pharmaceutical composition comprising a nucleic acid SEQ ID No. 4 and vector comprising said sequence, classified in class 536, subclass 23.1.

XIV. Claims 33-40 drawn to a pharmaceutical composition comprising a nucleic acid SEQ ID No. 6 and a vector comprising said sequence, classified in class 536, subclass 23.1.

XV. Claims 33-40 drawn to a pharmaceutical composition comprising antibody to SEQ ID No. 1, classified in 530, subclass 387.1+

XVI. Claims 33-40 drawn to a pharmaceutical composition comprising antibody to SEQ ID No. 2, classified in 530, subclass 387.1+

XVII. Claims 33-40 drawn to a pharmaceutical composition comprising antibody to SEQ ID No. 3, classified in 530, subclass 387.1+

XVIII. Claims 33-40 drawn to a pharmaceutical composition comprising antibody to SEQ ID No. 5, classified in 530, subclass 387.1+

XIX. Claims 33-40 drawn to a pharmaceutical composition comprising host cell comprising SEQ ID No. 1, classified in 435, subclass 320.1

XX. Claims 33-40 drawn to a pharmaceutical composition comprising host cell comprising SEQ ID No. 2, classified in 435, subclass 320.1

XXI. Claims 33-40 drawn to a pharmaceutical composition comprising host cell comprising SEQ ID No. 3, classified in 435, subclass 320.1

XXII. Claims 33-40 drawn to a pharmaceutical composition comprising host cell comprising SEQ ID No. 5, classified in 435, subclass 320.1

Claim 21 link(s) inventions I and VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 21. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the

instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Inventions [I-VI, XIII-XIV], VII-XII, XV-XVIII and XIX-XXII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are have different modes of operation and can be used in materially different processes. For example, the polynucleotides of Groups I-VI, XIII-XIV can be used in hybridization assays, whereas the other products cannot. The protein of Groups VII-XII can be used to make antibodies and in therapy, whereas the other compounds cannot. The antibodies of Groups XV-XVIII can be used in immunoassays, affinity purification etc, whereas the compounds of the other groups cannot.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Due to the complexity of this restriction, a telephone call was not made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Tuesday 5:30am-11:30am and Fridays 6:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheela J Huff
Primary Examiner
Art Unit 1642

sjh